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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/264,432

Applicant(s)

GOLDMAN ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,7,8,14,15,19,33-42,44,46,47 and 49-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,7,8,14,15,19,33-42,44,46,47 and 49-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 4, 5, 7, 8, 14, 15, 19, 33-42, 44, 46, 47, and 49-71 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the specification states that in connection with an embodiment solely using the most recent programming that the profile includes "information relating to only the most recently viewed television programming" (IA: Page 17, Lines 8-9). As such, there does not appear to be support in the specification as originally filled wherein the profile in such an embodiment would further "include . . . user information further characterizing the user, in addition to the television programming viewed by the user."
4. Claims 60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art

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that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filled discloses that the user profile is transmitted and stored at the IPS each time the user requests resources from the Internet, at the beginning of each Internet session, or periodically at any desired interval such as on a daily basis (IA: Page 20, Lines 9-14). However, it is unclear that the profile is necessarily "updated prior to each request for an information document", "updated prior to each new Internet session", or "updated prior to each new Internet session". For example, presuming that it is the user's first request for an information document, it is unclear as to how the profile might have been updated prior to the profile being sent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 4, 5, 7, 8, 14, 15, 19, 33-42, 44, 46, 49-51, 53, 63, 64, 66, 67, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128) in view of Bedard (US Pat No. 5,801,747).

In consideration of claim 34 and 44, the Perlman et al. reference shows the schematic structure of a communications network for use with a "computer program product having one or more computer-readable media having computer-executable instructions" for implementing a "information retrieval system" such as the WebTV® client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request for an information document from the server computer" [160] and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours and idle periods based upon a number of download criteria recognizable by those of ordinary skill in the art (Page 12, Lines 5-21). The "client system" [150] subsequently, "selects an advertisement from the advertisement repository" [220] and "inserts data representing the selected advertisement" into the retrieved "information documents" which are "displayed . . . including the advertisement" [105] (Page 13, Lines 22-28).

The aforementioned Perlman et al. reference, however, does not explicitly disclose, nor preclude, the particular usage of criteria such as that associated with a client system compiled profile". The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user" (Col 4, Lines 15-26 and 49-65). The "profile"

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may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to “include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements” for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Perlman et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

In consideration of claim 49 and 53, Figure 1B of the Perlman et al. reference discloses the general architecture of an “information retrieval system” including a “remote server” [160/175] (Page 5, Line 27 – Page 6, Line 2), an “ISP” [160/175] (Page 8, Lines 24-25), and a “client” [180] such as a WebTV® terminal having a “display device” [105] that “has access to television programming viewed by the user” through shared screen viewing of television/internet content. The system, which utilizes “a computer program product having one or more computer-readable media having computer-executable instructions”, is

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subsequently operable to insert an advertisement into a document displayed on the display device as previously set forth. In particular, the "remote server" [160/175] receives a request from the "client system" [180] for "an information document" upon which the "remote server" [160/175] "transmits the information document to the client system" (Page 5, Line 20 – Page 6, Line 18). The "client system" [180] subsequently, selects an advertisement from a local advertisement repository and "inserts data representing the selected advertisement" into the retrieved "information documents" (Page 13, Lines 22-28).

While the Perlman et al. reference discloses "accessing a profile of a user from the client system" in connection with "selecting an advertisement from an advertisement repository" for eventual "insertion into the information document based on the user profile" (Page 12, Lines 5-21), does not particularly disclose nor preclude the nature of the profile such that it contains "information related to only a most recently viewed television program". The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user" (Col 4, Lines 15-26 and 49-65). The "profile" may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to "include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements"

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for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Perlman et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

Claims 4 and 35 are rejected wherein the “act of inserting data representing the selected advertisement is conducted at the client system” (Perlman et al.: Page 18, Lines 11-20).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be “pre-downloaded” and stored in memory on the client system (Perlman et al.: Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the “information document” is a web page in HTML format (Perlman et al.: Page 7, Lines 29 – Page 8, Line 7).

Claims 8 and 38 are rejected wherein the Perlman et al. reference discloses that “act of compiling the profile includes an act of including in the profile user information further characterizing the user” such as information gathered from tracking web sites that the user may have visited (Perlman et al.: Page 12, Lines 5-14) in addition to the aforementioned “television programming viewed by the viewer” of Bedard.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including “news” [308] and “reference

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information related to the content of the television programming” such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be “pushed” to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that “push” technology does not require “direct user assistance”.

In consideration of claims 33 and 42, the combined references do not explicitly disclose nor preclude that the compiling of a “profile includes an act of identifying closed captioning received from television programming”. The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to develop viewership profiles based upon “identifying closed captioning received from television programming”. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to “identify closed captioning received from television programming” so as to provide a means for particularly classifying the characteristics (ex. category/sub-category) of viewed programming.

Claim 47 is rejected wherein the “selected advertisement is selected prior to requesting the information document” since Perlman et al. teaches that the advertisements are selected, downloaded, and locally cached prior to a user requesting a particular web page.

Claim 50 is rejected wherein “communications between the remote server and the client system pass through an ISP” since the ISP facilitates the delivery of the information document stored on cache of the remote server.

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Claim 51 is rejected wherein as aforementioned the “client system” [180] “displays the information document, including the selected advertisement” on the “display device of the client system” [105] (Perlman et al.: Page 18, Lines 11-20).

Claims 63 and 64 are rejected wherein the “user profile” of Bedard is “updated each time the client views a television program” for a meaningful duration since it only comprises one entry.

Claims 66 and 67 are rejected wherein the “user profile” of Bedard is “categorized according to topics of television programming” (Figure 2; Col 4, Lines 49-65).

Claims 69 and 70 are rejected wherein “information relating to the user profile is only retained in the user profile for only a set period of time” corresponding to the user watching a new program for a meaningful period.

8. Claims 46 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Bedard (US Pat No. 5,801,747), and in further view of Brown et al. (US Pat No. 5,887,133).

In consideration of claims 46 and 52, the Perlman et al. reference suggests that the “inserted data” or advertisements may be overlay any web page, however, it is unclear if it necessarily replaces a “preexisting advertisement that was included within the information document requested from the server” (Page 18, Lines 11-20).

The Brown et al. reference discloses a client device [56] capable of displaying television programming and “requesting . . . an information document from the server computer”. The client device selects an advertisement from an advertisement repository [24/26/28] for “replacing a preexisting advertisement included with the information document requested

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from the server” based upon the user profile [216] (Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize the teachings of Brown et al. so as to particularly select, insert, and display a requested information document comprising a targeted advertisement as claimed for the purpose of providing a means to deliver information of interest from the Internet through the replacement of undesirable advertisement content with other information of interest such as advertisement content based upon the users profile.

9. Claim 54-58, 60-62, 65, 68, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Pat No. 5,887,153) in view of Bedard (US Pat No. 5,801,747).

In consideration of claims 54 and 58, Figure 3 of the Brown et al. reference discloses an “information retrieval system” [200] including a “remote server” [14/16/22], an “ISP” [202], and a “client system” [214] having a “display device” [212] that is capable of displaying television programming (Col 3, Lines 63-65; Col 10, Lines 14-18). Accordingly, the “ISP” [202] “receives a request from the client system for an information document” from the “remote server” [14/16/22], “obtains the information document form the remote server”, “accesses a profile of a user from the client system”, “selects an advertisement from an advertisement repository” [34] “based on the user profile” [216] (advertisements may be considered information of interest, health-related information or warnings in the case of public service announcements as is understood in the art), “inserts data representing the selected advertisement into the information document” and “transmits the information

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document to the client system” (Brown et al.: Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33).

The Brown et al. reference, suggests that it may contain past activity data (Col 10, Lines 19-24), however does not particularly disclose that the “profile includes information related to only a most recently viewed television program” as particularly claimed. The Bedard reference discloses a PC-TV that is operable to “compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user” (Col 4, Lines 15-26 and 49-65). The “profile” may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to “include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements” for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Brown et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

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Claim 55 is rejected wherein the "ISP" implicitly "accesses and stores the profile prior to receiving the request for the information document". For example, it is unclear as to how the system would operate to swap an advertisement using a user profile if it has not already accessed and stored that profile for which the swap is based.

Claim 56 is rejected wherein the "client system displays the information document including the selected advertisement on the display device of the client system" (Brown et al.: Figures 8-9).

Claim 57 is rejected wherein the "selected advertisement replaces a preexisting advertisement included with the information document" (Brown et al.: Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33).

In consideration of claims 60-62, the combined references do not explicitly disclose nor preclude the particular timing associated with the updating of the remote user profile. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remotely update the singular record profile information routinely so as to advantageously ensure that the user is being provided with advertisements that reflect the user's most current interests. Accordingly, it would have been obvious for the "ISP to receive" an updated profile "each time the client requests an information document, such that the user profile is updated prior to each request for an information document" or "each time the client begins a new Internet session that is serviced by the ISP" in connection with establishing a session for the retrieving an information document or on a "daily basis" associated with the aforementioned establishment of sessions for the purpose of ensuring that

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user is being provided with advertisements that reflect the user's most current interests based upon the most recently viewed programming.

Claim 65 is rejected wherein the "user profile" of Bedard is "updated each time the client views a television program" for a meaningful duration given that it only comprises one entry.

Claim 68 is rejected wherein the "user profile" of Bedard is "categorized according to topics of television programming" (Figure 2; Col 4, Lines 49-65).

Claim 71 is rejected wherein "information relating to the user profile is only retained in the user profile for only a set period of time" corresponding to the user watching a new program for a meaningful period.

10. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Pat No. 5,887,153) in view of Bedard (US Pat No. 5,801,747) and in further view of Gupta et al. (US Pat No. 6,487,538).

In consideration of claim 59, the combined references do not explicitly disclose nor preclude that the "advertisement is selected by the ISP, based on the user profile, prior to receiving the request for the information document". The Gupta et al. reference discloses that it is known and advantageous for ISPs to "select [advertisements] . . . based on the user profile, prior to receiving [a] request for [an] information document" (Col 6, Lines 10-46).

Accordingly, it would have been obvious to one having ordinary skill in the art to modify the combined references such that the ISP [202] pre-selects and caches advertisements from the remote repository [34] based upon the user profile [216] for the purpose of decreasing the latency associated with the retrieval of targeted advertisements from a remote repository for eventual insertion into information documents.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Salganicoff (US Pat No. 5,734,720) reference discloses that it is known in the art to determine television viewership profiles based on monitoring and categorization of closed captioning information of viewed television programs (Col 13, Lines 30-40).
- The Markowitz et al. (US Pat NO. 6,311,185) reference discloses that it is known in the art to insert advertisements into web-pages based upon a profile either at the client, server, or ISP.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB

November 29, 2004



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